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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,668	01/21/2004	James White	1332-001	3406

7590 05/09/2006

LAW OFFICES OF ADAM H. JACOBS
SUITE 726
1904 FARNAM STREET
OMAHA, NE 68102

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding..

SP

Office Action Summary	Application No. 10/761,668	Applicant(s) WHITE ET AL.	
	Examiner Stephen L. Blau	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-10,13 and 14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6,8-10,13 and 14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The claims have two occurrences of claim 5. The second occurrence of claim 5 has been changed to claim 6 and the subsequent claims as well as the dependencies have been corrected (See enclosure (1)). Please make this same correction in future responses.

2. The amendment filed 13 February 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

a. The paragraph in the response page 2 lines 15-20 contains information of what type of shaft must be used and why which was not in the original disclosure.

b. The paragraph in the response page 2 lines 21 through page 3 line 3 contains information of how what type of weighting accommodates a certain type of action which was not in the original disclosure.

c. The replacement chart #2 contained flex values which were not there originally and are considered new matter. As such the new chart is not approved and has not been entered.

For parts 2a and 2b, the examiner recommends removing these two mentioned paragraphs to overcome objections 2a and 2b.

Applicant is required to cancel the new matter in the reply to this Office Action.

Specification

3. The specification stands objected under rule 1.71 Title 37 C.F.R. for not being written in a full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same. Specifically it is uncertain how the step of selecting a representative golf club is performed. Is it the favorite club (Page 15 lines 10-15) or is it based completely on the measured hand strength converted using Chart 1-A (Page 5, Lns. 2-10)? It appears that the BI index which the set will be matched to will be determined (based on) by either the measure grip strength (Claim 1, first paragraph of Summary of the Invention of page 5 as amendment on 13 February 2006, example shown in newly added paragraph the top of page 4 of amendment dated 13 February 2006) or the BI index determined by a players favorite club and described in the method of fitting on page 15 lines 1-21 of the specification. If there are two ways to determine the BI, the examiner suggests adding words on page 15 of the specification lines 1-21 which states that another way to select a BI index other than using grip strength is to use the BI index of a favorite club in order to overcome this objection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-6, 8-10 and 13-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this application it is uncertain how a representative club is selected. See paragraph 3 above. In claim 4 it states that the favorite club is used to select said representative golf club however in claim 1 it states that the representative club is based on the measured grip strength. It seems to the examiner that BI is either determined by grip strength as shown in Chart 1-A or by dissecting a favorite club as described in page 15 lines 1-21 but not both. In this application and especially in claim 4 it is uncertain how the BI is determined as well as the selection of the representative club. If the applicant agrees with the examiner's suggestion in paragraph 3 above and claim 4 is canceled, the examiner would remove these rejections.

6. Canceling 7 (original claim number 6) is agreed with and the rejection under 35 U.S.C. 112, second paragraph, is removed.

Specification

7. The disclosure is objected to because of the following informalities: The sheet in the appendix which contains pictures of the different shaft extensions is a drawing. It should be removed from the appendix and placed with the drawings with a figure number and a brief description of the drawings should be added to the specification.

Appropriate correction is required.

Response to Arguments

8. The argument that the added matter clarifies the fitting process is partly agreed with. However the examiner is still confused with how a representative club is selected. See paragraphs 3 and 5 above. The added paragraphs to the specification explain how the method is used when using grip strength to select a representative club to determine BI and page 15 of the specification explains how using a favorite club is used to determine the BI. The examiner request clarification if these are two different methods in determining BI which will be matched with the other clubs?

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/4 May 2006


STEPHEN BLAU
PRIMARY EXAMINER